

### REMARKS

Applicants thank the Examiner for total consideration given the present application. Claims 1-36 are currently pending of which claims 25-36 have been withdrawn from further consideration as being directed to a non-elected invention. Applicants appreciate that the previous arguments filed on April 25, 2007 were found persuasive. However, claims 1-24 now stand rejected under a new ground(s) of rejection. Claim 23 has been amended through this Reply. Applicants respectfully request reconsideration of the rejected claims in light of the remarks presented herein, and earnestly seek timely allowance of claims 1-24.

#### 35 U.S.C. § 112, 2ND PARAGRAPH REJECTION

Claim 23 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite because there is insufficient antecedent basis for the limitation "the contacting opening" recited in the claim. Claim 23 has been amended to recite "a contacting opening". Applicants respectfully submit that the amendments made to the claim do not add any new matter to the application, are not narrowing, and are not made for a reason relating to patentability. Accordingly, it is submitted that the amendment does not give rise to estoppel and, in future analysis, claim 23 is entitled to its full range of equivalents. Accordingly, Applicants respectfully request that the Section 112, second paragraph rejection of claim 23 be withdrawn.

#### 35 U.S.C. § 102 REJECTION - Johnson

Claims 1, 3, 6, 10-12, and 14-23 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Johnson et al. (USPN 6,104,388) ("Johnson"). Applicants respectfully traverse this rejection.

For a Section 102 rejection to be proper, the cited reference must teach or suggest each and every claimed element. *See M.P.E.P. 2131; M.P.E.P. 706.02*. Thus, if the cited reference fails to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, Johnson fails to teach or suggest each and every claimed element. For example, independent claim 1 recites, *inter alia*, “wherein the sensor arrangement is designed as a modular unit with an electrode element and a closure element that are mutually arranged in an essentially electrically insulated initial position, that one of said elements is arranged to receive said force from the pen stem and thereby be urged to an activated position in electrical contact with the other element, . . .” *Emphasis added*. Applicants respectfully submit that Johnson fails to disclose the above-identified claim features.

Johnson merely discloses a conventional pen with a force-responsive transducer which is able to generate electrical signals that are proportional to the varying degree or magnitude of the force exerted on the writing surface by the marking tip of the pen. The writing tip 21 of the pen 11 is carried by a cartridge 27, which has a projection 51. A transducer cell 55 is mounted within the rear end of the pen 11. The cartridge 27 is normally biased or held away from the transducer cell 55. As shown in Fig. 2B, inward travel of cartridge 27 in response to a force exerted on the writing surface by the writing tip positions the guide member tip 51 in pressure contact with the transducer cell 55 (*see column 3, lines 48-53*). The pressure-responsive transducer comprises a strain gauge 53. The strain gauge 53 is cooperably positioned with end 33 of cartridge 27 such that the inward travel of cartridge 27 exerts a force via tip 51 on the diaphragm of cell 55 proximate strain gauge 53 thereby, in a manner well known in the art, changing the electrical characteristics of the strain gauge 53 (*see column 4, lines 43-59*).

Johnson is distinguished from the claimed invention in that, in Johnson, the above-mentioned sensor arrangement is not designed as a modular unit with an electrode element and a closure element that are mutually arranged in an essentially electrically insulated initial position. The Examiner alleges that in Fig. 2A, Johnson discloses that the sensor arrangement is designed as a modular unit with an electrode element and closure element (*see page 3, last full paragraph of the Office Action*). The Examiner’s such allegation is totally unfounded. Fig. 2A clearly shows that the guide member tip 51 is separate from the transducer cell 55. Thus, in Johnson, the sensor arrangement cannot be designed as a modular unit with an electrode element and a closure element.

Johnson is further distinguished from the claimed invention in that nowhere does Johnson teach or suggest that one of said elements (the electrode element and the closure element) is arranged to receive said force from the pen stem and thereby be urged to an activated position in electrical contact (emphasis added) with the other element. In Johnson, the guide member tip 51 is not in electrical contact with the cell 55 or the strain gauge 53. The tip 51 merely makes contact with the diaphragm of the cell 55 for causing a strain that may be sensed by the strain gauge 53. Indeed, the Examiner acknowledges that the tip 51 receives force from the cartridge 27 so that the tip 51 contacts with the strain gauge 53 and the cell 55 (*see page 4, first full paragraph of the Office Action*). However, nowhere does Johnson disclose or suggest that this contact between the tip 51 and the cell 55 is an electrical contact.

Therefore, for at least these reasons, independent claim 1 is distinguishable from Johnson. Claims 3, 6, 10-12, and 14-23 depend from claim 1, directly or indirectly. Therefore, for at least the reasons stated with respect to claim 1 and further in view of novel features recited therein, claims 2-4 and 6-11 are also distinguishable from Johnson.

Accordingly, Applicants respectfully request that the rejection of claims 1, 3, 6, 10-12, and 14-23, based on Johnson, be withdrawn.

35 U.S.C. § 103 REJECTION - Johnson

Claim 24 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johnson. Applicants respectfully traverse. Claim 24 depends from claim 1. Therefore, for at least the reasons stated with respect to claim 1, claim 24 is also distinguishable from Johnson.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johnson in view of Nagai et al. (USPN 6,104,388 of record)("Nagai"). Claim 5 depends from claim 1. As demonstrated above, Johnson fails to teach or suggest "wherein the sensor arrangement is designed as a modular unit with an electrode element and a closure element that are mutually arranged in an essentially electrically insulated initial position, that one of said elements is *arranged to receive said force from the pen stem and thereby be urged to an*

*activated position in electrical contact with the other element, . . .*" as recited in claim 1. Nagai has not been, and indeed cannot be, relied upon to correct at least this deficiency of Johnson. Thus, it is respectfully submitted that claim 5 is distinguishable from the combination of Johnson and Nagai.

Claims 2, 4, 7-9, and 13 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Johnson in view of Rockwell et al. (USPN 5,357,062)("Rockwell"). These claims depend from claim 1, directly or indirectly. As demonstrated above, Johnson fails to teach or suggest "wherein the sensor arrangement is designed as a modular unit with an electrode element and a closure element that are mutually arranged in an essentially electrically insulated initial position, that one of said elements is *arranged to receive said force from the pen stem and thereby be urged to an activated position in electrical contact with the other element, . . .*" as recited in claim 1. Rockwell has not been, and indeed cannot be, relied upon to correct at least this deficiency of Johnson. Rockwell merely discloses a pen cursor for use in performing writing motions on the surface of a tablet wherein a sensor is mounted in a tip portion of the pen cursor to develop a signal output indicating longitudinal force on a writing tip of the pen cursor. Accordingly, it is respectfully submitted that claims 2, 4, 7-9, and 13 are distinguishable from the combination of Johnson and Rockwell.

### **Conclusion**


In view of the above remarks, it is believed that claims 1-24 are allowable.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Ali M. Imam Reg. No. 58,755 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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